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| APPLICATION NO.             | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO.     | CONFIRMATION NO. |
|-----------------------------|-------------|----------------------|-------------------------|------------------|
| 09/533,263                  | 03/17/2000  | Wilbur J. Walkoc JR. | 8285/347                | 7066             |
| 757                         | 7590        | 04/05/2004           | EXAMINER                |                  |
| GENERAL NUMBER 00757        |             |                      | PIZARRO, RICARDO M      |                  |
| BRINKS HOFER GILSON & LIONE |             |                      | ART UNIT                | PAPER NUMBER     |
| P.O. BOX 10395              |             |                      | 2661                    | 8                |
| CHICAGO, IL 60611           |             |                      | DATE MAILED: 04/05/2004 |                  |

Please find below and/or attached an Office communication concerning this application or proceeding.

|                              |                        |                     |
|------------------------------|------------------------|---------------------|
| <b>Office Action Summary</b> | <b>Application No.</b> | <b>Applicant(s)</b> |
|                              | 09/533,263             | WALKOE ET AL.       |
|                              | <b>Examiner</b>        | <b>Art Unit</b>     |
|                              | Ricardo M. Pizarro     | 2661                |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

1) Responsive to communication(s) filed on Phone call on 3/24/04.

2a) This action is **FINAL**.                    2b) This action is non-final.

3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

4) Claim(s) 1-62 is/are pending in the application.

4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.

5) Claim(s) \_\_\_\_\_ is/are allowed.

6) Claim(s) 1-47, 49,54-55, 59-60 is/are rejected.

7) Claim(s) 48,50-53,56-58 and 61 is/are objected to.

8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

9) The specification is objected to by the Examiner.

10) The drawing(s) filed on \_\_\_\_\_ is/are: a) accepted or b) objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a) All    b) Some \* c) None of:

1. Certified copies of the priority documents have been received.
2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

|   |   |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input checked="" type="checkbox"/> Interview Summary (PTO-413)          |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                    | Paper No(s)/Mail Date. _____.   |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____. | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
|   | 6) <input type="checkbox"/> Other: _____.                                   |

## **DETAILED ACTION**

### ***Claim Objections***

1. Claims 1-26, 37-41, 43-45 and 50-53 are objected to because of the following informalities and it is suggested to applicant

In claim 1 lines 3 and 8 insert “at least one” before -digital-, in line 25 replace “an” with -a-.

In claim 10 line 3 replace “an” with -said-. In claim 13 line 3 insert “the plurality of” before -call-.

In claim 19 line 1 replace the second occurrence of “the” with -a-, in line 2 replace the second occurrence of “a” with -the-, in line 4 replace “the” with -a-. In claim 20 line 2 insert “the” before -digital, in line 3 insert “the” before -coder/decoder-.

In claim 26 line 2 insert “interface unit” after -line-.

In claim 37 line 5 delete “with said subscriber loop” since it is duplicated.

In claim 43 line 3 replace “the” with -a-.

In claim 44 line 3 replace “a” with -said-.

In claim 45 line 5 replace “a” with -said-

In claim 50 line 1 replace “a” with -the-, in line 2 replace “a” with -the-.

Appropriate correction is required.

### ***Claim Rejections - 35 USC § 112***

2. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Art Unit: 2661

3. Claims 55-59 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

4. Claim 55 recites the limitation "the switching device" in line 3. There is insufficient antecedent basis for this limitation in the claim.

***Claim Rejections - 35 USC § 102***

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

**A person shall be entitled to a patent unless –**

**(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.**

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) and the Intellectual Property and High Technology Technical Amendments Act of 2002 do not apply when the reference is a U.S. patent resulting directly or indirectly from an international application filed before November 29, 2000. Therefore, the prior art date of the reference is determined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

6. Claims 1-6,18-21 and 23-26 are rejected under 35 U.S.C. 102(e) as being anticipated by Fornek.

US patent no. 5,305,312 ( Fornek et al) discloses an apparatus for interfacing analog telephones and digital data terminals to an ISDN line, comprising: a subscriber unit ( element 200 in Fig. 1) for connection with a public switched telephone network ( i.e. element 116 in Fig. 1) having at least one switch ( element 100 in Fig. 1) and at least one digital subscriber line (element 125 in Fig. 1, col 1 lines 39-41) in communication with said switch, comprising: a digital subscriber line interface unit ( element 270 in fig. 1) in communication with the DSL for receiving a plurality of data packets from the DSL ( i.e. elements 130 and 124 in Fig. 1) for identifying selected ones of said plurality of packets corresponding to a received data stream on a first derived digital telephone line and for transmitting on the DSL a plurality of transmitted data packets corresponding to a transmitted data stream of the first received digital telephone line, a coder decoder ( elements 225 and 240) in communication with the DSL interface unit ( element 27) in communication with element 225 in Fig. 1) for receiving the transmitted data stream for coding the transmitted data stream into the plurality of transmitted data packets for receiving the plurality of received data packets and for decoding the plurality of received data packets into the received data stream ( col 9 lines 38-43), an analog-to-digital converter ( element 250, col 6 lines 53-55) in communication with the coder-decoder, a digital-to-analog converter ( col 6 lines 53-55) , a user interface unit ( elements 126, 130, 225, 233 , 251 and 252) in communication with the analog-to-digital converter and the digital-to-analog converter, as in claim 1; said user interface unit comprises a telephone keypad and a DMTF tone generator ( keypad in element 126 and DMTF element 252 in Fig. 2), as in claim 2; wherein the user interface unit comprises a

telephone handset and a switch hook ( in element 126 in Fig. 2), as in claim 3; said unit comprises a telephone interface unit (element 251 in Fig. 2), as in claim 4; said unit comprises an alert signal generator (telephone ringer ,col 6 lines 11-17), as in claim 5; said unit comprises a processor (element 225 in Fig. 2), as in claim 6; said unit comprises a smart card interface( smart card reader 233 in Fig. 2) , as in claim 18; said processor is capable of downloading a plurality of smart card data from a smart card inserted in said unit( col 8 lines 25-26, 32-36), as in claim 19; said processor is coupled is coupled to said coder/decoder and wherein said DSL interface and coder encoder are capable for accepting data corresponding to a second derived digital telephone line( element 225 and 270 in Fig. 2, col 4 lines 61-64, col 6 lines 68-69, col 7 line 1), as in claim 20; where the subscriber unit in response to a signal generated by the user interface is capable initiating the second derived line( both B channels may be used, col 5 lines 36-38), as in claim 21; wherein the processor is coupled to the coder/decoder (element 225 ), as in claim 23; wherein the communication with the first data service over the digital subscribe loop uses data packets that do not correspond to the first derived telephone line( col 9 lines 51-54), as in claim 24; wherein the user interface unit further comprises a display driver ( element 130 and 132 in Fig. 2), as in claim 25.

7. Claims 27-36, 37-41 are rejected under 35 U.S.C. 102(e) as being anticipated by Whittaker.

US patent No. 6,130,893 ( Whittaker et al) discloses a Method and apparatus for multiplexing telephone lines over a common access network comprising a telephone communication system comprising an analog telephone line( element 25 in Fig. 1) having analog voice signal ( element 30 ) carried by a subscriber loop ( element 12 in Fig.) and a digital line sharing said subscriber loop with said analog telephone line, said

digital line having a digital voice channel ( col 1 lines 29-30) for placing telephone voice calls, as in claims 27, 37; wherein the analog telephone line and the digital data line simultaneously provide two or more voice channels ( plurality of voice channels, col 1 line 31) over the subscriber loop, as in claim 28; wherein the analog telephone line comprises a POTS line 9 ( element 30 in Fig. 2), as in claim 29; wherein the digital data line comprises a high capacity digital subscriber line ( ADSL col 2 line 57), as in claim 30; wherein the digital data line comprises an asymmetric digital subscriber line ( ADSL col 2 line 57) , as in claim 31; wherein the digital data line comprises multiple data and voice channels, as in claim 32; wherein the digital data line comprises an ATM protocol ( col 3 line 5) , as in claim 33; wherein said digital voice channel is carried by an ATM protocol ( col 3 line 5), as in claim 35; a central office switch ( col 1 line 61), as in claim 38; a digital carrier line including a digital carrier system ( 12 in Fig.1), as in claim 39; means for separating analog voice signal from digital data signals( 24 in Fig. 1), as in claim 40; said means is a splitter ( splitter 24), as in claim 41.

8. Claims 42-45 are rejected under 35 U.S.C. 102(e) as being anticipated by Whittaker. US patent No. 6,130,893 ( Whittaker et al) discloses a Method and apparatus for multiplexing telephone lines over a common access network comprising a method for providing a digital telephone line comprising providing an analog telephone line ( element 30 ) with analog voice signals carried on a subscriber loop ( access loop 12 in Fig. 1), providing digital data line on said loop with said analog telephone line( element 30 in Fig. 1), said digital data line having a digital voice channel ( col 1 lines 29-30) and placing a telephone voice call over the digital voice channel of said digital data line( col 5 lines 35-36), as in claim 42; interfacing said telephone voice call carried by a data protocol to a switch protocol ( col 5 lines 31-42), as in claim 43; wherein said step of interfacing said comprises converting a telephone voice signal carried by

the data protocol to said switch protocol ( col 5 lines 31-42), as in claim 44; converting said telephone voice call carried by the data protocol to an analog voice signal and converting said analog voice signal to said switch protocol( col 5 lines 31-42), as in claim 45.

9. Claims 46-47 are rejected under 35 U.S.C. 102(e) as being anticipated by Whittaker. US patent No. 6,130,893 ( Whittaker et al) discloses a Method and apparatus for multiplexing telephone lines over a common access network comprising a subscriber location for use in a telecommunication system, said location comprising a subscriber loop (access loop 12 in Fig. 1)carrying an analog telephone voice line and a digital data line wherein the digital data line comprises an asymmetric digital subscriber line having a digital telephone voice line , a digital telephone ( col 5 lines 35-36) in communication with the subscriber loop, a POTS telephone (col 5 line 35) in communication with the subscriber loop, wherein the subscriber location provides for separate telephone voice calls on the digital telephone ( col 5 lines 35-36) and the POTS telephone ( col 3 line 16) over the subscriber loop, as in claim 46; said loop comprises a copper twisted pair ( col 2 line 60), as in claim 47.

10. Claim 49 is rejected under 35 U.S.C. 102(e) as being anticipated by Whittaker. US patent No. 6,130,893 ( Whittaker et al) discloses a Method and apparatus for multiplexing telephone lines over a common access network comprising a method of placing a telephone voice call over a PSTN ( col 5 line 35) comprising providing a subscriber loop ( access loop 12 in Fig. 1) in communication with the PSTN, said loop having an analog loop (analog loop 15 in Fig. 1) in communication with the PSTN, said loop having an analog telephone voice line ( col 3 line 16) and a digital data line ( col 5 lines 35-36) wherein the digital data line comprises a digital telephone voice line ( voice channel, col 1 line 31) and placing a telephone voice call

from a digital telephone in communication with the digital voice line ( col 5 lines 31-42), as in claim 49.

11. Claims 54-55, 59-50 are rejected under 35 U.S.C. 102(e) as being anticipated by Whittaker.

US patent No. 6,130,893 ( Whittaker et al) discloses a Method and apparatus for multiplexing telephone lines over a common access network comprising a telephone system including at least one digital telephone in communication with a digital telephone voice( col 5 lines 35-36) on a digital data line, at least one pots telephone (col 5 line 35) in communication with an analog line, a network interface device ( interface device 21 in Fig. 1) connected to a subscriber loop ( access loop 12 in Fig. 1), wherein the network interface comprises a signal splitter ( splitter 24 in Fig. 1) configured to combine telephone voice signal received from the analog telephone line and digital data line onto the subscriber loop and separate telephone voice signals received from the subscriber loop ( access loop 12 in Fig. 1) onto an appropriate one of the analog telephone line and digital data line, the subscriber loop carrying the digital data line and the analog telephone line on a common communication medium and a central office ( col 1 line 61) configure to communicate with the subscriber loop, the central office switch having a splitter ( terminal adapter , col 1 line 63) for separating signals on the subscriber loop into analog telephone line telephone voice signals and digital data lines, wherein the digital data signals comprise voice line voice signals( said adapter splits the signals into digital and analog, col 2 lines 4-6), as in claim 54; wherein the central switch office further comprises a local telephone switching device, as in claim 55; the common communication medium is copper twisted pair ( col 2 line 60), as in claim 59; the digital line is an ADSL (col 2 line 60), as in claim 60.

***Claim Rejections - 35 USC § 103***

12. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

13. Claims 7-17 and 22 are rejected under 35 U.S.C. 103(a) as being unpatentable over Fornek

Regarding claim 7-11 and 12-16 Fornek did not specifically disclose said interface unit has a display unit, as in claim 7; said display unit in communication with said display unit, as in claim 8; said processor capable of receiving and decoding caller identification data, as in claim 9; said interface unit comprises a call memory in communication with the processor, as in claim 10; a plurality of data relating to an incoming call includes a facsimile message, as in claim 11; said display unit is capable of displaying a plurality of options, as in claim 12; said interface unit comprises a plurality of additional keys adjacent to the display unit, as in claim 13; said interface unit further comprises a call memory for storing the plurality of data, as in claim 14; the plurality of data relating an outgoing call includes a duration of the call , as in claim 15; the plurality of data relating an outgoing call includes a destination number, as in claim 16.

Therefore it would have been obvious to one of skill in the art that a telephone can have a plurality of user friendly options such as a display unit and the like ( claim 7-8, 14-16), a caller id feature that stores telephone number of incoming calls ( claim 9-10); said display unit shows

control options such a redial ( claim 12) or an additional set of keys that allow the user to switch outgoing lines or the like ( claim 13) with the motivation of providing a user interface to an ISDN digital subscriber line for both analog telephones and digital data terminals.

Fornek discloses said user interface unit further comprises a data interface unit for downloading a plurality of stored data to an external device ( col 6 lines 61-62), as in claim 16.

Regarding claim 22 Fornek did not specifically disclose said subscriber unit capable of initiating up to N derived lines, as in claim 22.

Therefore it would have been obvious to one of skill in the art to have a unit capable of initiating said lines since Fornek discloses a unit that initiates a call on more than one derived lines and that a primary rate ISDN line has more than two B-channels, with the motivation of providing a user interface to an ISDN digital subscriber line for both analog telephones and digital data terminals.

***Allowable Subject Matter***

14. Claims 48, 50-53 , 56-58 and 61 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claim. Please also notice objection to claims.

***Conclusion***

11. As agreed on 3/24/04 with applicant's representative a supplemental non-final action is hereby issued, due to group of claims not being cited in previous action.

**Any response to this action should be mailed to:**

Commissioner of Patents and Trademarks

Washington, D.C. 20231

**or faxed to:**

(703) 872-9314

(for formal communications intended for entry, for informal or draft communications, please  
label "PROPOSED" or "DRAFT")

Hand-delivered responses should be brought to Crystal Park II, 2121 Crystal Drive,  
Arlington, VA., Sixth Floor (Receptionist).

Any inquiry concerning this communication or earlier communications from the examiner  
should be directed to **Ricardo Pizarro** whose telephone number is (703) 305-1121. The  
examiner can normally be reached on Monday-Friday from 9:00 AM to 5:30 PM. The fax  
number for this Group is (703) 872-9314.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's  
supervisor, **Douglas Olms**, can be reached on (703) 305-4703.

Any inquiry of a general nature or relating to the status of this application or proceeding  
should be directed to the Group receptionist whose telephone number is (703) 305-4700.

March 24, 2004

*Ricardo M. Pizarro*

*Douglas W. Olms*

DOUGLAS OLMS  
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